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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,284	01/29/2001	Samuel Nochumson	260/243	2969

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EXAMINER

OWENS JR, HOWARD V

ART UNIT PAPER NUMBER

1623

DATE MAILED: 10/02/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/774,284

Applicant(s)

NOCHUMSON ET AL.

Examiner

Howard V Owens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6,7.                      6) ☐ Other: .

### DETAILED ACTION

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

#### Abstract Objected to: Minor Informalities:

The Abstract of the Disclosure is objected to because of the bracketed number present on the first line. Appropriate correction is required. See M.P.E.P. § 608.01(b).

#### Claim Rejections – 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by either Ogawa et al., EP 0517515 A2, or Thatcher et al., U.S. 5,981,735 or Merion et al., Biotechniques, Vol. 7(1), pp. 60-67, 1989, or Davis et al., Biotechniques, Vol. 21, pp. 92-99, July, 1996.

Claim 1 is drawn to a process for isolating plasmid DNA comprising the steps of lysing cells containing said plasma DNA with a lysis agent, treating with a high salt agent with subsequent purification.

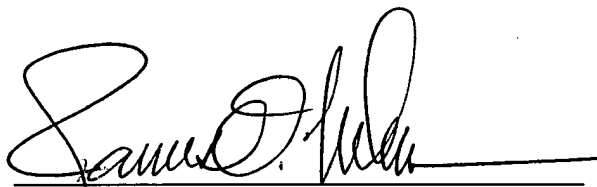
Thatcher et al. anticipates the claim cited supra as it teaches a method for the isolation of plasma DNA using an alkaline lysis, treatment with a high salt agent- 3 M potassium acetate, with subsequent chromatography purification (col. 15, lines 13-67).

Ogawa et al. anticipates the claim cited supra as it teaches a method for the isolation of plasma DNA using alkaline lysis, treating with a neutral or high salt buffer with subsequent ultrafiltration purification (p.2, col.2, lines 11-58).

Merion et al. anticipates the claim cited supra as it teaches a method for the isolation of plasma DNA using an alkaline lysis agent (p. 61, col.1), treating with a high salt agent to remove contaminating proteins and precipitate the plasmid DNA, with subsequent chromatography purification.

Davis et al. anticipates the claim cited supra as it teaches a method for the isolation of plasma DNA using an alkaline lysis agent (p. 94, col. 1), treating with a high salt agent, CsCl which accomplishes the subsequent purification as well.

Howard V. Owens  
Patent Examiner  
Art Unit 1623

A handwritten signature in black ink, appearing to read "James O. Wilson", written over a horizontal line.

James O. Wilson  
Supervisory Patent Examiner  
Technology Center 1600

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Owens whose telephone number is (703) 306-4538 . The examiner can normally be reached on Tue.-Fri. from 7:30 a.m. to 6 p.m. If attempts to reach the examiner are unsuccessful, the examiner's supervisor can be reached at (703) 308-4624.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone number for this Group is (703) 308-4556.